IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: XU et al.

Serial No.: 10/751,230

Filed: January 2, 2004

For: Method and System for More Effective Protein

Group: 1631 Confirmation No. 1114

Examiner: BORIN, MICHAEL DOCKET: GLH 08-896943

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT A

Dear Sir:

This is in response to the Official Action mailed December 2, 2005. Provisional election is hereby made, with traverse, to prosecute the invention of Group I, comprising claims 1-13 and 15.

The restriction requirement is respectfully traversed. The Official Action has not established a prima facie justification for the requirement for election. The Official Action states, "The inventions...are related as independent methods...A reference teaching one method will not teach or support the other method."

In the Official Action, the reference made therein to unpatentability of one method

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vis-à-vis the other method is irrelevant to a restriction requirement. A requirement for restriction has nothing to do with unpatentability of claims for any of the inventions being claimed. It is agreed that a rejection of any claim cannot be based on unpatentability implied to such a claim due to unpatentability of another claim. The sole basis for unpatentability resides in the statutes. The statutes do not authorize unpatentability to be implied from other claims of the same application. Nothing in the statutes permits unpatentability of claims to be based on unpatentability being implied from unpatentable other claims. A restriction requirement has nothing to do with patentability or unpatentability.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor *per se* is not a basis for determining distinctiveness in accordance with MPEP 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC §121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements, not having been met here vis-à-vis Groups I and II respectively, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

It should be noted that the restriction requirements as prescribed by 35 USC §121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicants provisionally elect to prosecute Group I, i.e.

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Claims 1-13 and 15, and it is requested that, without further action thereon, the remaining claim 14 be retained in this application pending disposition of the application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,

Norman P. Soloway
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 22, 2005, at Tucson, Arizona.

By Kim Good

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